

SECTION II: REMARKS

A. Summary of Amendments and Support Therefor

By the present amendment, claims 1, 7, 13, and 20 have been amended, to clarify that the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system. Such claim amendments are supported by the originally-filed specification, for example, at page 7, line 22 – page 8, line 3. No new matter within the meaning of 35 U.S.C. 132 has been introduced by the foregoing amendments.

B. Allowable Subject Matter; Response to Claim Objections

In the April 27, 2009 Office Action, the examiner indicated that claims 3-6, 9-12, and 16-19 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims in each instance¹. No amendments to claims 3-6, 9-12, and 16-19 are made herewith, in view of the arguments supporting patentability of the base claims on which 3-6, 9-12, and 16-19 depend. Applicant reserves the right, if necessary, to re-write claims 3-6, 9-12, and 16-19 as indicated by the examiner at a later time.

C. Response to Claim Rejections Under 35 U.S.C. 112

In the April 27, 2009 Office Action, claims 1-24 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the examiner alleged that claims 1, 7, 13, and 20 did “not clearly indicat[e] what elements should be displayed on the monitor screen².”

¹ April 27, 2009 Office Action, page 7.

² April 27, 2009 Office Action, page 2.

Claims 1, 7, 13, and 20 as previously presented each referred to “a user interface associated with said user interface application program and displayed on a monitor screen associated with said connected processing system.” (Emphasis added.) The second participle phrase “displayed on a monitor screen associated with said connected processing system” applies to the “user interface,” in the same manner as the first participle phrase “associated with said user interface application program” applies to the “user interface.” Applicant submits that claims 1, 7, 13, and 20 as previously presented are clear, such that no amendment is necessary under 35 U.S.C. 112, second paragraph. Despite such position, however, claims 1, 7, 13, and 20 have been amended herewith to state “wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said connected processing system,” to eliminate any possible objection based on clarity of claims 1, 7, 13, and 20.

Based on the foregoing amendments, withdrawal of the claim rejections under 35 U.S.C. 112, second paragraph, is warranted, and is respectfully requested.

D. Response to Claim Rejections Under 35 U.S.C. 103

The April 27, 2009 Office Action contained multiple rejections under 35 U.S.C. 103, namely:

- a rejection of claims 1, 2, 7, 8, 13, 14, 20, and 21 as being unpatentable for obviousness over allegedly “Admitted Prior Art” (hereinafter, “APA”) in view of U.S. Patent No. 7,237,198 to Chaney (hereinafter, “Chaney”);
- a rejection of claim 15 as being unpatentable for obviousness over APA in view of Chaney, as applied to claim 1, and further in view of U.S. Patent No. 5,991,520 to Smyers et al. (hereinafter, “Smyers”);
- a rejection of claim 22 as being unpatentable for obviousness over APA in view of Chaney, as applied to claim 13, and further in view of U.S. Patent No. 6,762,798 to Messer et al. (hereinafter, “Messer”); and

- a rejection of claims 23-24 as being unpatentable for obviousness over APA in view of Chaney, as applied to claim 13, in view of Messer and further in view of Smyers.

The foregoing rejections are discussed below.

1. The Examiner Has Misinterpreted Background Statements Made by Applicant Relating to Alleged "Admitted Prior Art"

In the April 27, 2009 Office Action at page 3 thereof, the examiner characterized the alleged "Admitted Prior Art" as disclosing "a DAPD³ ..., a connected processing system ... , the external interface (playback device ...), a user interface application program (a UI software application ...), a memory ..., storing ..., a DAPD application programming interface (API) (the libraries ... contain implementations of application programming interfaces ...⁴."

To the extent that the examiner is characterizing background statements made by Applicant as suggesting that a DAPD includes a memory storing an application programming interface (API), Applicant disagrees. Applicant hereby disputes the examiner's characterization of alleged Admitted Prior Art. It appears that the examiner has confused various elements of a DAPD with a connected device. In order to dispel such confusion, characteristics of a DAPD are compared with characteristics of a connected device below.

<u>Characteristic of conventional "DAPD"</u>	<u>Characteristic of conventional "Connected Device"</u>
May be embodied in portable a MP3 player ⁵	May be embodied in a personal computer (PC) ⁶
Includes "on-board user interface" ⁷	Includes "connected user interface" ⁸ implemented in software resident on the connected device ⁹

³ DAPD refers to digital audio playback device.

⁴ April 27, 2009 Office Action, pages 2-3.

⁵ Application, page 3, lines 1-3.

⁶ Application, page 3, lines 10-11 and lines 14-17; page 4, lines 5-16; page 5, lines 3-7.

<u>Characteristic of conventional "DAPD"</u>	<u>Characteristic of conventional "Connected Device"</u>
Control functions may be activated by "only three or four control buttons" and a tiny LCD ¹⁰	Control function may be activated by mouse ¹¹
Display may embody "tiny LCD" ¹²	Display ¹³ may include monitor screen
On-board user interface may be used to control audio playback	Common for DAPD to be "controlled by user interface on a connected device" when DAPD "is connected to the PC [connected device], usually through some kind of cradle device" ¹⁴
When user is finished configuring audio files on DAPD, DAPD is disconnected from connected device and DAPD may be carried by the user ¹⁵	Connected device may be used to erase audio files from DAPD and download new audio files to DAPD when DAPD is connected to connected device ¹⁶
Memory used to store audio files ¹⁷	User interface software libraries (e.g., device drivers and application programming interfaces to communicate with and control a DAPD over a PC connection) may be downloaded from the Internet and reside on the connected device ¹⁸
On-board user interface used to control single DAPD only ¹⁹	User interface application storable on a connected device may be used to operated any of several DAPDs available in the market ²⁰

Thus, as demonstrated in the foregoing table, a conventional DAPD is distinct from a conventional connected device in multiple aspects – even though both a

⁷ Application, page 4, lines 1-2.

⁸ Application, page 4, lines 3-4.

⁹ Application, page 3, lines 14-16; page 4, line 22 – page 5, line 3; page 5, line 23 – page 7, line 3.

¹⁰ Application, page 3, lines 17-22.

¹¹ Application, page 4, lines 5-11.

¹² Application, page 3, lines 17-22.

¹³ Application, page 4, lines 5-7.

¹⁴ Application, page 4, line 22 – page 5, line 1; page 4, lines 5-16.

¹⁵ Application, page 4, lines 16-19.

¹⁶ Application, page 4, lines 11-16.

¹⁷ Application, page 2, lines 15-18.

¹⁸ Application, page 4, line 22 – page 5, line 10.

¹⁹ Application, page 3, lines 6-9.

²⁰ Application, page 5, lines 18-19.

conventional DAPD and a conventional connected device may be used to control aspects of a DAPD.

At page 3 of the April 27, 2009 Office Action, the examiner conceded that “APA does not teach reverse DAPD API²¹ capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system.” Applicant agrees with the foregoing statement by the examiner.

2. Chaney Fails to Disclose a Reverse DAPD API Capable of External Interface Causing a Processor to Access and Control a User

At pages 3-4 of the April 27, 2009 Office Action, the examiner alleged:

“...Chaney teaches reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system [wherein] ... the client computer 104 (playback device) comprises a network interface 140, an electronic music player 144, a music renderer controller 148, and device drivers 152A-152M ... (... a music player for displaying one or more graphical interfaces that comprise information about music items, wherein the music player provides an application programming interface that enables device drivers to modify the music player’s graphical user interface; a music renderer; and a device driver for sending music items to the music renderer, wherein the device driver displays a graphical interface including at least one control object for managing the music items

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modifying (*sic – modify*) the teaching [of] APA with Chaney to incorporate the feature of reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system because this provides augmented or improved circuit content with playback of DVD content because this gives the music renderer manufacturers flexibility to define what actions can be performed with respect to the music renderer²².”

²¹ “DAPD API” refers to digital audio playback device (DAPD) application programming interface (API).

²² April 27, 2009 Office Action, pages 3-4.

Applicant disagrees with the examiner's characterization of Chaney's disclosure and the examiner's resulting conclusion of obviousness.

Chaney discloses a music player 144²³ that operates (e.g., as a software program²⁴) on a client computer 104, and that is arranged to communicate with multiple music renderers 126A-126N. A music renderer controller 148²⁵ and device drivers 152A-122M that reside in the client computer 104 enable communication with the music renderers 126A-126N. The client computer 104 further includes a network interface 140 that enables communication with an external music server 128 via a communication network 120.

For demonstrative purposes, and without conceding disclosure by Chaney of any specific element(s) of Applicant's claims, the closest analog to the "digital audio playback device (DAPD)" of Applicant's claims in Chaney's disclosure is Chaney's "music renderer" 126A. Likewise, the closest analog to the "connected processing system" of Applicant's claims in Chaney's disclosure is Chaney's "client computer 104." Referring to Chaney FIG. 1 (reproduced below), Chaney draws a clear distinction between the client computer 104 and the music renderers 126A-126N.

²³ It is noted that U.S. Patent No. 7,237,198 is assigned to RealNetworks, Inc., and the "music player 144" appears to correspond in character to the "RealPlayer" application that is widely distributed by RealNetworks, Inc.

²⁴ See Chaney, col. 4, lines 58-65 and claim 5 ("wherein the music player is a program executing on a computer").

²⁵ The music renderer controller 148 comprises a device integration application program interface (DIAPI) that provides a predefined interface for communicating with the device drivers 152A 152M.

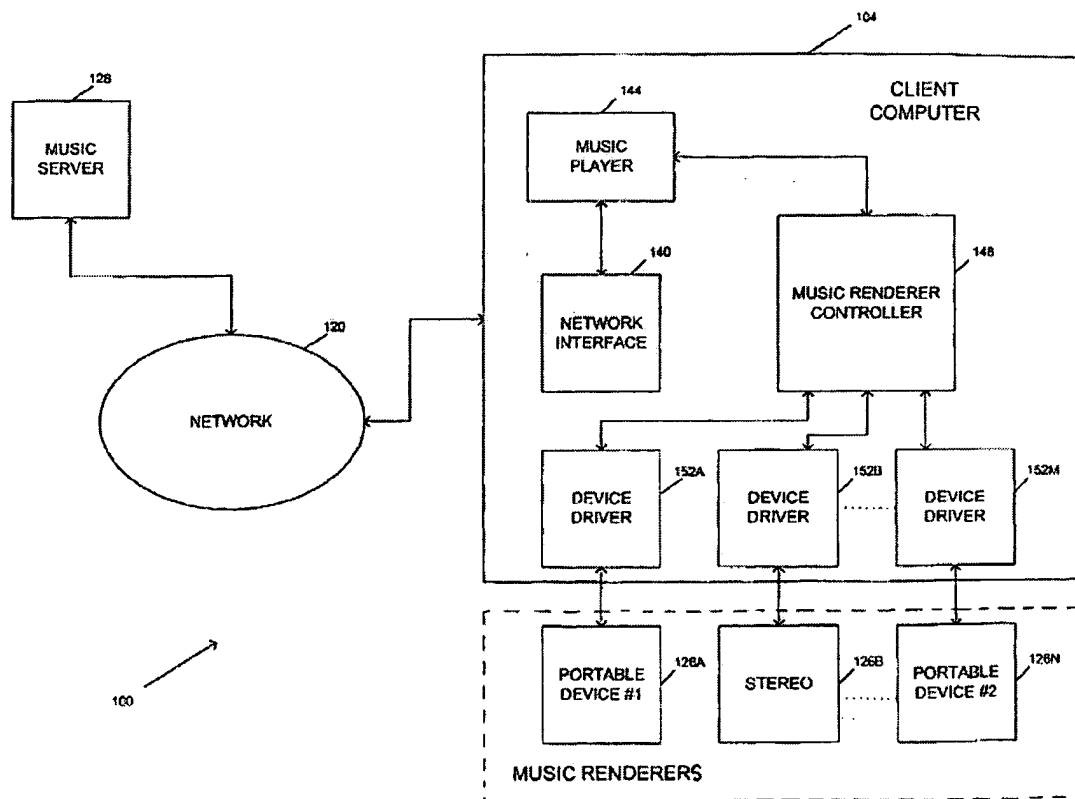


FIG. 1

As is clear from Chaney FIG. 1 and Chaney col. 3, lines 56-59, Chaney's device drivers 152A-152M are contained in the client computer 104. Chaney's device drivers 152A-152M include application program interfaces (APIs) enabling communication with Chaney's music renderer controller 148²⁶. Chaney states at page 6, lines 14-15 thereof that "[a] **device driver can provide controls for the music renderer**," and that a device driver associated with the music player 148 (within Chaney's client computer 104) can integrate any new control windows into the music renderer. Moreover, Chaney discloses that "each device driver can customize the control portion depending on the requirement of the music renderer that is being managed by the device driver"²⁷. The foregoing features are entirely consistent with Chaney's control of a music renderer (126A-126N) by the client computer 104.

²⁶ Chaney, col. 5, lines 41-44.

²⁷ Chaney, col. 8, lines 65-67.

Chaney's control of a music renderer by the client computer 104 is further emphasized by Chaney col. 10, lines 21-28, as reproduced below:

“[B]y using the DIAPI, changes in firmware of one of the music renderers 126A 126N do not necessitate changes in the electronic music player 144. If additional features are provided with respect to one the music renderers 126A 126N, a new device driver may be created to communicate with the music renderer controller 148 and thereby allow the user to take advantage of such new features without requiring a re-design of the music player.”

The foregoing excerpt makes clear that a new device driver may be created to enable communication with a music renderer after a firmware update of the music renderer. Nothing in the foregoing passage – or indeed anywhere in Chaney's disclosure – suggests transmission of any API from a music renderer to Chaney's client computer 104.

All of the control features disclosed by Chaney relate to a client computer controlling a music renderer – NOT a music renderer controlling a client computer. It is therefore clear that **Chaney does not disclose a reverse DAPD application programming interface (API)** adapted to cause a processor (of the digital audio playback device) to access and control a user interface associated with a user interface application program executed on a connected processing system.

For at least the reason that Chaney does not disclose a reverse DAPD application programming interface as recited in Applicant's independent claims 1, 7, 13, and 20, the proposed combination of allegedly “Admitted Prior Art” and Chaney does not disclose all elements of Applicant's independent claims 1, 7, 13, and 20. Accordingly, withdrawal of the rejections of Applicant's independent claims 1, 7, 13, and 20 is warranted, and is respectfully requested.

Since dependent claims inherently include all of the limitations of the claims on which they depend²⁸, the claims depending (whether directly or indirectly) from independent claims 1, 7, 13, and 20 are likewise distinguished over the allegedly “Admitted Prior Art” and Chaney. Accordingly, withdrawal of the rejections of claims 2, 8, 14, and 21 is warranted, and is respectfully requested.

Neither Smyers nor Messer remedy the above-identified deficiencies of allegedly “Admitted Prior Art” and Chaney in disclosing all elements of Applicant's independent

²⁸ 35 U.S.C. 112, fourth paragraph.

claims 1, 7, 13, and 20. Smyers discloses an API for managing and automatic data transfer operations between applications over a bus structure; Smyers is not concerned with any reverse DAPD API. Messer discloses methods and apparatuses for providing video control for television applications; Messer is not concerned with any reverse DAPD API. As no combination of Smyers and/or Messer with the allegedly “Admitted Prior Art” and Chaney embodies all elements of Applicant’s independent claims 1, 7, 13, and 20 (or the claims depending therefrom), withdrawal of the rejections of dependent claims 15 and 22-24²⁹ is warranted, and is respectfully requested.

3. The Examiner Has Not Provided Articulated Reasoning With Rational Underpinning to Support Legal Conclusions of Obviousness

It is fundamental to a proper rejection of claims under 35 U.S.C. § 103 that an examiner must present a convincing line of reasoning supporting the rejection. MPEP 2144 (“Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). The Supreme Court affirmed the validity of such approach, stating that **“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”** *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385, 1396 (2007). In *KSR*, the Supreme Court further confirmed that **references that teach away from the invention are evidence of the non-obviousness** of a claimed invention, (*KSR*, 82 USPQ2d at 1395, 1399) and reaffirmed the principle that a factfinder judging patentability “should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”

Following *KSR*, the Federal Circuit held that although “rigid” application of the “teaching, suggestion, or motivation” (“TSM”) test for obviousness is improper, **application of a flexible TSM test remains the primary guarantee against improper “hindsight” analysis**, because a flexibly applied TSM test ensures that the obviousness analysis proceeds on the basis of evidence in existence before time the application was filed, as required by 35 U.S.C. § 103. *Ortho-McNeil Pharm. Inc. v. Mylan Labs., Inc.*, 520 F3d 1358, 86 USPQ2d 1196, 1201-02 (Fed. Cir. 2008).

²⁹ These dependent claims inherently include all the elements of the claims on which they depend, pursuant to 35 U.S.C. 112, fourth paragraph.

In the April 27, 2009 Office Action, the examiner proposed the following reason for combining the purported Admitted Prior Art, Chapen, and Messer to yield the subject matter of claim 22:

“It would have been obvious to one of ordinary skill at the time the invention was made to combine the teaching of APA, Chaney with Messer to incorporate the feature of API, which identifies a manufacturer of said digital audio playback device, and wherein said reverse API is capable of causing an identity of the manufacturer to be displayed because this enables a video window to be translated as well as scaled to accommodate a variety of televisions³⁰.”

The foregoing proposed reason (i.e., “enable[ing] a video window to be translated as well as scaled to accommodate a variety of televisions”) is not inherently tied to Applicant’s invention embodied in claim 22. For example, accuracy and timeliness of information and ease of use do not compel the element of “the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device.” In this regard, the reasoning is not rationally related to the claim, such that the examiner has failed to provide “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” as required by *KSR* to support an obviousness rejection of claim 22. It appears that the examiner has advanced arguments reliant upon “*ex post* reasoning” due to an improper hindsight bias based upon knowledge of Applicant’s disclosure; the Federal Circuit has cautioned against such methodology (following the Supreme Court’s *KSR* decision) in *Ortho-McNeil Pharm. Inc. v. Mylan Labs., Inc.*, *supra*.

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³⁰ April 27, 2009 Office Action, page 6.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the now-pending claims are in condition for allowance. Examination of the enclosed claims and issuance of a notice of allowance are earnestly solicited. Should any issues remain that may be amenable to telephonic resolution, the examiner is invited to telephone the undersigned attorneys to resolve such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

Respectfully submitted,

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Dated: July 27, 2009

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